

Attorney Docket No.: 42.P9234
Application No.: 09/671,957
Page 6

REMARKS

Claims 4-9, 13, and 33-38 remain pending. Claims 1-3, 14-18, and 30-32 have been canceled by this Amendment without prejudice or disclaimer of the subject matter therein.

In the Office Action, the Examiner rejected claims 1-3, 13, 16, 17, and 30-32 under 35 U.S.C. § 102(e) as being anticipated by Wee et al. (U.S. Patent No. 6,553,150); rejected claim 18 under 35 U.S.C. § 103(a) as unpatentable over Wee et al.; rejected claims 4-6 and 33-35 under 35 U.S.C. § 103(a) as unpatentable over Koyanagi et al. (U.S. Patent No. 5,557,332) in view of Wee et al.; rejected claims 7-9 and 33-36 under 35 U.S.C. § 103(a) as unpatentable over Krishnamurthy et al. (U.S. Patent No. 6,496,607); rejected claim 14 under 35 U.S.C. § 103(a) as unpatentable over Wee et al. in view of Koyanagi et al.; and stated that claim 15 would be allowable if rewritten in independent form.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Claims 4-6 and 33-35:

Applicant respectfully traverses the § 103(a) rejection of claims 4-6 and 33-35 over Koyanagi et al. in view of Wee et al.. Independent claims 4 and 33 require a method and medium including, *inter alia*, “decoding at least the set of slices but not the plurality of slices into a plurality of macroblocks having a set of macroblocks within the area; and decoding at least the set of macroblocks but not the plurality of macroblocks into pixels.” The combination of Koyanagi et al. and Wee et al., even if it were proper, fails to teach or suggest all elements of the claimed method and medium.

Page 5 of the Office Action alleges that col. 24, lines 39-53, of Wee et al. teach or suggest “only decoding a set of slices.” Page 5 of the Office Action does not allege or show that Wee et al. teaches or suggests “decoding at least the set of macroblocks but not the plurality of

Attorney Docket No.: 42.P9234

Application No.: 09/671,957

Page 7

macroblocks into pixels," as set forth in claims 4 and 33. Hence, a *prima facie* case of obviousness has not been established for these claims, because neither Koyanagi et al. nor Wee et al. has been shown to teach or suggest this second decoding limitation.

Nor does the cited portion of Wee et al. teach or suggest this second decoding limitation. The relevant part, col. 24, lines 43-47, states only:

Using this mapping, for example, if one desired to extract a ball only from a compressed representation of FIG. 15, one would need to identify and decode both regions "A" and "C," which would include ball data.

While this portion of Wee et al. arguably teaches decoding certain slices but not others (in view of Fig. 15, which segments an image by slices), it does not teach or suggest decoding certain macroblocks but not others within decoded slices, as set forth in claims 4 and 33. This portion of Wee et al., taken at face value, teaches or suggests decoding all macroblocks within a slice. It does not teach or suggest different decoding treatment of macroblocks within slices.

As a further example of this slice-only disclosure of Wee et al., see col. 24, line 57, through col. 25, line 3, which refer to Figs. 17-19 that indicate type of data by slice, and not by macroblock within the slices. Thus, the cited portion of Wee et al., and the rest of Wee et al., fails to teach or suggest at least "decoding at least the set of macroblocks but not the plurality of macroblocks into pixels" as required by claims 4 and 33.

Because the combination of Koyanagi et al. and Wee et al. fails to teach or suggest all elements of independent claims 4 and 33, a *prima facie* case of obviousness has not been established for these claims.

A *prima facie* case of obviousness also has not been established for claims 4 and 33, because no motivation or suggestion has been shown to combine Koyanagi et al. and Wee et al.. Page 5 of the Office Action points to a problem disclosed, and solved, by Wee et al. as allegedly motivating the combination with Koyanagi et al. This, however, is circular logic. Pointing to an advantage or solution to a problem in one reference (i.e., Wee et al.) does *not* provide motivation to solve this problem in the other reference (i.e., Koyanagi et al.) unless that other reference has the same problem or deficiency or need as the first. In the Office Action, there has been no

Attorney Docket No.: 42.P9234
Application No.: 09/671,957
Page 8

showing that Koyanagi et al. has the problem of having to decode an entire image even if only a small part of the image is being edited (Wee et al., col. 2, lines 7-9).

In fact, Koyanagi et al. is primarily concerned with decoding entire images using parallel processing (see Abstract). Koyanagi et al. is not concerned with editing only part of an image, the problem genesis in Wee et al. Because Koyanagi et al. does not have the need or deficiency that Wee et al. cures, one of ordinary skill in the art would not have been motivated to add the teachings from Wee et al. A *prima facie* case of obviousness also has not been established for claims 4 and 33 for at least this additional reason.

Because a *prima facie* case of obviousness has not been established for claims 4 and 33, the § 103(a) rejections of these claims are improper and should be withdrawn. Claims 5, 6, 34, and 35 are allowable at least by virtue of their dependency from claims 4 and 33.

Claims 7-9 and 36-38:

Applicant respectfully traverses the § 103(a) rejection of claims 7-9 and 36-38 over Krishnamurthy et al. Independent claims 7 and 36 require a method and medium including, *inter alia*, "transmitting the first substream to a first recipient; and transmitting the second substream to a second recipient that is different than the first recipient." The proposed modification of Krishnamurthy et al., even if it were proper, fails to teach or suggest all elements of the claimed method and medium.

Krishnamurthy et al. fails to teach or suggest transmitting a second substream to a second recipient that is different than a first recipient of a first substream. To the contrary, various embodiments of Krishnamurthy et al. appear to contemplate a single recipient for all transmitted substreams. See, for example, col. 4, lines 42, 43, and 60 ("where the compositing function is left with *the decoder*." (emphasis added)). At most, Krishnamurthy et al. appears to teach or suggest sending multiple substreams to a *single recipient*.

Page 6 of the Office Action does not propose modifying Krishnamurthy et al. to send the second substream to a second recipient that is different from the first recipient. Instead, it proposes modifying the reference "to allow a second user to select a second different region of interest." This is not "transmitting the second substream to a second recipient that is different

Attorney Docket No.: 42.P9234

Application No.: 09/671,957

Page 9

than the first recipient," as set forth in claims 7 and 36. Thus, even if Krishnamurthy et al. were modified as suggested, it still fails to teach or suggest all limitations of the claims.

Hence, a *prima facie* case of obviousness cannot be established for claims 7 and 36 as amended, because Krishnamurthy et al. as modified fails to teach or suggest all elements of the claims. The § 103(a) rejection of claims 7 and 36 should be withdrawn.

A *prima facie* case of obviousness also has not been established for claims 7 and 36, because no motivation or suggestion has been shown to modify Krishnamurthy et al. as proposed. Page 6 of the Office Action contains only the bare legal conclusion that "it would have been obvious . . ." No evidence from either reference or other technical reasoning has been provided to support this conclusion. Without any supporting evidence or facts, a *prima facie* case of obviousness cannot be established. See M.P.E.P. § 2142 ("The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness."). A *prima facie* case of obviousness also has not been established for claims 4 and 33 for at least this additional reason.

Applicant also notes, in passing, that Official Notice is only proper for establishing *facts* (see M.P.E.P. § 2144.03: "In limited circumstances, it is appropriate for an examiner to take official notice of facts not in the record"). Because obviousness is a legal conclusion, and not a fact, the mention of Official Notice on page 6 of the Office Action is improper and is hereby traversed.

Because a *prima facie* case of obviousness has not been established for claims 7 and 36 over Krishnamurthy et al., the § 103(a) rejections of claims 7 and 36 are improper and should be withdrawn. Claims 8, 9, 37, and 38 are allowable at least by virtue of their dependency from claims 7 and 36.

Claim 13:

Applicant respectfully traverses the § 102(e) rejection of claim 13 over Wee et al. Independent claim 13, as amended, requires a method including, *inter alia*, "transmitting the plurality of different new MPEG pictures to a corresponding plurality of different nodes." Wee et al. fails to teach or suggest all elements of the claimed method.

Attorney Docket No.: 42.P9234
Application No.: 09/671,957
Page 10

Neither Fig. 2 nor col. 12, lines 19-21, of Wee et al. teaches or suggests transmitting a plurality of different new pictures to a corresponding plurality of different nodes. Rather, it only teaches a single computer 133. Hence, Wee et al. fails to teach or suggest all elements of claim 13, as amended.

Krishnamurthy et al., even as modified in the Office Action, also fails to teach or suggest all elements of claim 13, for the reasons given above with regard to claim 7. Thus, the stated rejection of claim 13 over Wee et al. is improper and should be withdrawn.


Reconsideration and allowance of pending claims 4-9, 13, and 33-38 are respectfully requested.

In the event that any outstanding matters remain in this application, Applicant requests that the Examiner contact Alan Pedersen-Giles, attorney for Applicant, at the number below to discuss such matters.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0221 and please credit any excess fees to such deposit account.

Respectfully submitted,

Dated: June 23, 2005



Alan Pedersen-Giles
Registration No. 39,996

c/o Intel Americas
LF3
4030 Lafayette Center Drive
Chantilly, VA 20151
(703) 633-1061